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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/797,394
Filing Date: March 08, 2004
Appellant(s): CARTER ET AL.

Adrian T. Calderone
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 December 2007 appealing from the Office action mailed 18 April 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,013,729	Tsujimoto et al.	01-2000
WO 96/16110	Karrer et al.	05-1996

A certified translation of WO 96/16110 from the French has been made of record.

(9) Grounds of Rejection

The following ground of rejection is applicable to the appealed claims:

Claims 1, 14, 18, 19, 33 and 34 stand rejected under 35 USC § 103(a) as being unpatentable over US Patent 6,013,729 (Tsujimoto hereinafter) in view of International Patent Application Publication WO 96/16110 (Karrer hereinafter).

Tsujimoto teaches an elastomer composition—including linear organohydrogensiloxanes crosslinked with a platinum-vinylsiloxane complex (Column 4 Line 36 – Column 6 Line 3) and other additives such as hindered amine light stabilizers (Column 9 Lines 20-29).

Tsujimoto does not disclose expressly the use of organosiloxane modified hindered amines.

Karrer discloses polyorganosiloxanes, including those with sterically hindered tertiary amine functionality with a pendant siloxane chain (Title, Abstract and Formula of Page 14).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the polyorganosiloxane hindered amines of Karrer in the composition of Tsujimoto. The motivation to do so would have been to improve the light stabilization of polymers (Karrer Abstract).

Regarding claim 34, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Further, since Tsujimoto and Karrer combine to teach the composition as claimed, the curability of the Tsujimoto/Karrer composition would inherently be the same as claimed. Appellants have not identified any persuasive evidence to the contrary.

(10) Response to Argument

Appellant argues that Tsujimoto fails to teach an polyorganosiloxane as claimed since Tsujimoto teaches an elastomeric component—particularly an ethylene- α -olefin diene copolymer—crosslinked with a silicone type crosslinking agent; however, the crosslinking agent taught—specifically compounds II-2 and II-3 (Column 4 Line 36 – Column 6 Line 3) meet the limitations of the instant claims and the ethylene- α -olefin diene copolymer, since it does not contribute alternating cyclic hydrocarbon residues, meets the limitation of 'polyorganosiloxane'. Further, independent claims 1 and 33 use the transitional term 'comprising', which is inclusive or open-ended and does not

exclude additional, unrecited elements such as the ethylene- α -olefin diene copolymer taught by Tsujimoto.

Appellant further argues that Tsujimoto is nonanalogous art, asserting that the composition taught fails to meet the limitation polyorganosiloxane—which is answered above, that there is no concern for transparency or haze and that Tsujimoto teaches that the composition can also include filler that would render the composition opaque; however, first, Tsujimoto is analogous art as it meets the test that it is in the field of Appellant's endeavor—that is it is directed to a structurally similar polyorganosiloxane compositions (see *In re Bigio*, 72 USPQ2d 1209, 1212 (Fed. Cir. 2004))("Because substantial evidence supports the Board's factual findings regarding the function and structure of the toothbrush art, this court affirms those findings."); second, it is noted that the features upon which appellant relies (i.e., transparency and haze) are not recited in the rejected claims—although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (see *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed Cir 1993)) and third, the opaque fillers of Tsujimoto are taught as being optional and further use the transitional term 'comprising', which is inclusive or open-ended and does not exclude additional, unrecited elements such as the fillers taught by Tsujimoto.

Appellant still further argues that the vinylsiloxane of claim 18 does not contain alkoxy groups; however, in the siloxane of Tsujimoto, alkoxy groups may be present, but are not required and therefore the reference meets the claims.

Appellant further argues that claim 34 requires heat curing while Tsujimoto teaches moisture curing; however, claim 34 requires that the composition be "curable to form a thin film by heating" and it is the examiner's position that since Tsujimoto and Karrer combine to teach the same composition as claimed, the curability and formability into thin films of the Tsujimoto/Karrer composition would inherently be the same as claimed. Appellants have not identified any persuasive evidence to the contrary.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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